



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,070	08/29/2005	Dietmar Muller	0740-71	7543
615 7590 01/29/2010				
THE MAXHAM FIRM				
9330 SCRANTON ROAD, SUITE 350				
SAN DIEGO, CA 92121				
EXAMINER				
WENDELL, ANDREW				
ART UNIT		PAPER NUMBER		
2618				
MAIL DATE		DELIVERY MODE		
01/29/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,070

Applicant(s)

MULLER ET AL.

Examiner

ANDREW WENDELL

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/2009 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 9-16 and 22-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson et al. (US Pat Pub# 2004/0203903).

As for claim 9, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network (Abstract and Page 15, Para 0163-0165), wherein the SIM card is configured in such a manner that with the SIM card the terminal device can be connected to only defined destination or source addresses, or both (Sections 0129 and 0165, only users addresses on the friend list are granted

permission to communicate with device); and wherein the defined destination and source addresses to which the terminal device can be connected are stored in a memory of the SIM card or in a database of the mobile communication network (Page 15, Para 0163-0165, teaches storing friend list on a removable memory such as a SIM card).

As for claims 10 & 28-32, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein said SIM card is designed as a Telematic SIM card and wherein the SIM card supports other services that are typically not understood to be Telematic services (Page 1, Para 0003-0004 and Section 0039).

As for claims 11-12, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the destination and source addresses are phone numbers, URLs (Uniform Resource Locator) or APN's (Access Point Name) (Page 5, Para 0067; Page 6, Para 0077; Page 14, Para 0155; and Page 15, Para 0163- 0165).

As for claims 13-16, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the SIM card only supports defined telecommunication services (Abstract; Sections 0039 and 0043; Page 12, Para 0129; and Page 15, Para 0163-0165).

As for claims 22-27, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the SIM card encompasses more than one different subscriber relationship, wherein the use of the

SIM card is assigned according to the originator principle to the respective subscriber relationship (Abstract; Page 2, Para 0045; Page 3, Para 0051; Page 4, Para 0056; Page 5, Para 0066; Page 9, Para 0104; Page 12, Para 0129; and Page 15, Para 0163-0165).

Regarding claim 33, process claim 33 is rejected for the same reason as apparatus claim 9 since the recited elements would perform the claimed steps.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. (US Pat Pub# 2004/0203903) in view of Lipsanen et al. (US Pat Pub# 2002/0059614).

As for claims 17-21, Wilson et al. teaches the limitations in claims 9-13. Wilson fails to teach a virtual private network.

Lipsanen teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the mobile phone subscriber relationship associated with the SIM card can only be operated within a defined virtual private network (Page 4, Para 0040-0042 and Page 6, Para 0065, VPN certificates in SIM card).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the storing of VPN information on a SIM card

as taught by Lipsanen into Wilson's apparatus in order to receive communication services easier (Section 0009).

6. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. (US Pat Pub# 2004/0203903) in view of Zabawskyj et al (US Pat Pub# 2004/0229601).

As for claims 34 and 35, Wilson et al. teaches the limitations in claims 9 and 33. Wilson fails to teach a customized application mobile enhanced logic.

Zabawskyj teaches wherein the ability to connect the terminal device to only defined destination or source addresses, or both, is limited via CAMEL (Sections 0032 and 0037, CAMEL defines a destination or source address of a phone number or Intelligent network services).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a customized application mobile enhanced logic as taught by Zabawskyj into Wilson's apparatus in order to simplify to a single phone number for a user (Sections 0011-0012).

Response to Arguments

Applicant's Remarks	Examiner's Response
"Wilson does not suggest configuring a SIM card of a mobile terminal device in such a manner that with the SIM card the terminal device can be connected to only defined destination or source addresses,	See Examiner's response to this remark filed on the non-final action filed on 3/6/2009. Further, In response to applicant's argument that the references fail to show certain features of applicant's

<p>or both, as required by claim 9. Examples of such defined destination and source addresses are recited in the Specification and in the dependent claims as phone numbers, URLs (Uniform Resource Locators), and APN's (Access Point Names)."</p>	<p>invention, it is noted that the features upon which applicant relies (i.e., phone numbers, URLs, APN's, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See <i>In re Van Geuns</i>, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).</p>
<p>"Wilson neither discloses nor suggests the claimed function of limiting connection of their terminal device to only defined destination and/or source addresses that are stored in a SIM of their terminal device or in a database of a mobile communication network, as required by claims 9 and 33."</p>	<p>See Examiner's response to this remark filed on the non-final action filed on 3/6/2009. Examiner has no further comment at this time.</p>
<p>"It is respectfully submitted that the Examiner's "species" explanation is unreasonable because learning the location of a person's terminal device is not a species of limiting the address to</p>	<p>Examiner basically reiterated the above responses. Again, the claims are broader than what the applicant interpretations of the claim. Wilson reasonably reads on the present limitations.</p>

which the terminal device can be connected."	
--	--

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW WENDELL whose telephone number is (571)272-0557. The examiner can normally be reached on 8:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Wendell/
Examiner, Art Unit 2618

1/23/2010